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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/089,126

08/05/2002

Brett Smith

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EXAMINER

SORKOWITZ, DANIEL M

ART UNIT

PAPER NUMBER

4137

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/089,126	Applicant(s) SMITH ET AL.	
	Examiner DANIEL M. SORKOWITZ	Art Unit 4137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Status of Claims

DETAILED ACTION

Notice to Applicant

This communication is in response to the 371 application filed on 8/5/2002.

Claims 1-30 have been examined.

Claim Rejections - 35 USC §112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 1 appears to be a hybrid claim. See MPEP §2173.05(p) II. In particular, it is unclear if claim 1 is drawn to a product or a process. Evidence to support a position that the claim is drawn to a product includes the recitation of: “a system” in line 1. On the other hand, evidence to support a position that the claim is drawn to a process includes: the step of “the consumer receives said advertising material” in line 10; and

the step of “the consumer receives rewards...” in line 12. . It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

4. Claims 2-16 are also rejected as each depends from claim 1.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1,17 rejected under 35 U.S.C. 102(b) as anticipated by US Patent Number 5,794, to Goldhaber et al. (hereinafter “Goldhaber”)

7. Regarding claim 1, Goldhaber clearly discloses a system comprising; a consumer station which receives electronic data or images (figure 4, 104, col. 11, lines 11-14); an information provider which delivers said electronic data or images to said consumer station (fig. 1, 106, col. 9 lines 39-41), a host having a website with which said consumer station communicates and interacts (fig. 1, 106, col. 9 lines 39-

41), an advertising provider in communication with said host (fig. 1, 106, col. 9 lines 66-67); wherein the advertising provider communicates via said host with said consumer station via the internet upon election by said consumer station responsive to an invitation from said host (fig. 3, 56, col. 10 lines 44-48); wherein, without requiring software downloaded and installed into the consumer station, the consumer receives said advertising material by responding to a random invitation from the host, which appears at the consumer station wherein, when said consumer elects to view advertising from said advertising provider via said host, the consumer receives rewards, credits or benefits commensurate with the length of time advertising is viewed.(fig 3 60, col. 10 lines 53-57).

8. Regarding claim 17, substantially similar to claim 1, and thus rejected under similar analysis.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 2-16, 17-30 rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber in view of US Patent Number 6,928,615 to Haitsuka et al. (hereinafter "Haitsuka").

11. Regarding claim 2, Goldhaber does not explicitly teach an invitation cancelling itself and reappearing randomly at a later time. Haitsuka clearly discloses a predetermined idleness criteria such that in the event the consumer station fails to respond to the random invitation within a predetermined period, the invitation will cancel itself and reappear at a later time at the consumer station allowing the consumer repeated opportunity to elect whether to receive advertising material while on line.(fig. 2, 110, col. 12 lines 7-10). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Goldhaber and Haitsuka to have a predetermined idleness criteria such that in the event the consumer station fails to respond to the random invitation within a predetermined period, the invitation will cancel itself and reappear at a later time at the consumer station allowing the consumer repeated opportunity to elect whether to receive advertising material while on line. Haitsuka teaches that this process permits browsing by the user and displaying of advertisements by the client application without interfering with the user's use of the browser application (col.12 lines 19-20).

12. Regarding claim 3, Goldhaber clearly discloses viewing advertising simultaneously with information from an information provider at the option of the

consumer, thereby allowing the consumer to offset the cost of on line time commensurate with the extent of exposure to advertising provided by the advertising provider (col. lines 50-57).

13. Regarding claim 4, Goldhaber clearly discloses an advertising station remote from a consumer station (fig. 1 110, col. 9 lines 62-66)

14. Regarding claim 5, Haitsuka clearly discloses a flashing icon (col. 10 lines 10-15).

15. Regarding claim 6, Goldhaber clearly discloses where consumer station is a computer (fig. 1 104, col. 9 lines 35-38).

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16. Regarding claim 7 Haitsuka clearly discloses wherein said consumer station is a digital television receiver, web pad or Wireless Application Protocol phone (fig. 1 100, col. 5 lines 9-13).

17. Regarding claim 8, Haitsuka clearly discloses advertisements appearing on a computer, video or television screen at a predetermined location on the screen (Fig.5 210, col.10. lines 1-3).

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18. Regarding claim 9, Haitsuka clearly discloses advertisements appearing in a banner (Fig.5 210, col.10. lines 11-15).

19. Regarding claim 10, Haitsuka clearly discloses an icon appearing in a banner (Fig.5 210, col.10. lines 11-15).

20. Regarding claim 11, Haitsuka clearly discloses a movable banner(Fig.5 210, col.10. lines 11-15).

21. Regarding claim 12, Haitsuka clearly discloses an icon visible irrespective of its location within said banner and when received on a consumer computer is enabled by an internet browser appearing in a banner (Fig.5 210, col.10. lines 11-15).

22. Regarding claim 13, Haitsuka clearly discloses advertising displayed independent of any data or images displayed on said screen at said consumer station (col. 12 lines 18-20).

23. Regarding claim 14 Haitsuka clearly discloses using a standard web browser to view advertisements (fig. 1 160, col. 5 lines 46-48).

24. Regarding claim 15 Goldhaber clearly discloses a consumer registering with said advertising provider by providing a consumer profile and email address. (Fig. 7 124 col. 13 lines 28-30)

25. Regarding claim 16 Goldhaber clearly discloses rewards comprising rebates to consumers for the costs of internet time commensurate with the time spent viewing advertising. (fig. 3 60, col. 10 lines 54-57).

Regarding claim 18, substantially similar to claim 2, and thus rejected under similar analysis.

26. . Regarding claim 19, substantially similar to claim 13, and 16 and thus rejected under similar analysis.

27. Regarding claim 20, substantially similar to claim 4 and thus rejected under similar analysis.

28. Regarding claim 21, substantially similar to claim 2 and thus rejected under similar analysis.

29. Regarding claim 22, substantially similar to claim 5 and thus rejected under similar analysis.

30. Regarding claim 23, substantially similar to claim 15 and thus rejected under similar analysis.

31. Regarding claim 24, method claim substantially similar to system claim 2 and thus rejected under similar analysis.

32. Regarding claim 25, Haitsuka clearly discloses displaying advertising targeted to a consumer profile until such time as the consumer cancels the advertising. (col. 11 lines 51-55)

33. Regarding claim 26, Goldhaber clearly discloses sending particulars of the consumer computer such as the computer's Email address to the advertising provider to establish a consumer profile link between the consumer computer and the advertising provider computer (col. 12 lines 24-29).

34. Regarding claim 27-30, substantially similar to claim 26, and thus rejected under similar analysis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL M. SORKOWITZ whose telephone number is (571)270-5206. The examiner can normally be reached on Monday through Friday from 8:30AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel M Sorkowitz/
Examiner, Art Unit 4137

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/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 4137